



UNITED STATES PATENT AND TRADEMARK OFFICE

R2002-163  
COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

AUG 12 2002

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to question 47 of the morning section and questions 27, 38 and 48 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On February 4, 2002 petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to

each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been granted no additional points on the Examination. No credit has been awarded for morning question 47 and afternoon questions 27, 38, and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 47 reads as follows:

47. Registered practitioner Rick drafted a patent application for inventor Sam. The application was filed in the USPTO on May 15, 2000, with a power of attorney appointing Rick. On March 15, 2001, Sam filed a revocation of the power of attorney to Rick, and a new power of attorney appointing registered practitioner Dave. In a non-final Office action dated September 12, 2001, the examiner included a requirement for information, requiring Dave to submit a copy of any non-patent literature, published application, or patent that was used to draft the application. Which of the following, if timely submitted by Dave in reply to the requirement for information, will be accepted as a complete reply to the requirement for information?

(A) A statement by Dave that the information required to be submitted is unknown and is not readily available to Dave.

(B) A statement by Dave that the requirement for information is improper because it was included in a non-final Office action.

(D) A statement by Dave that the requirement for information is improper because information used to draft a patent application may not be required unless the examiner identifies the existence of a relevant database known by Sam that could be searched for a particular aspect of the invention.

(E) None of the above.

The model answer is selection (A).

37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR 1.105(b). (C) is incorrect because 37 CFR 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR 1.105. (E) is incorrect because (A) is correct.

Petitioner argues that Dave is not the inventor or the attorney or the persons who prepared the application as required in 37 CFR 1.56(c) and accordingly he cannot declare that the information is unknown. Petitioner further argues that because there is no evidence that Dave made a "good faith" effort to acquire the information therefore the information could have been known and readily available. Petitioner believes that answer (E) should be accepted as a correct answer.

Petitioner's arguments have been fully considered but are not deemed persuasive. The question asks "Which of the following, if timely submitted by Dave in reply to the requirement for information, **will be accepted as a complete reply** to the requirement for information?" (Emphasis added). The question is only asking what will be accepted by the Office as a complete reply. Clearly, answer (A) *will be accepted as a complete reply* by the Office. This policy is set forth in 37 CFR 1.105(a)(3). 37 CFR 1.105 effective November 7, 2000, "changes to Implement the Patent Business Goals; Final Rule," September 2000, 65 FR 54604, 54634; MPEP § 704.12 (b). The Office does not require a showing of efforts made to obtain the information. The statement that the information required to be submitted is unknown and not readily available is generally accepted "on its face".

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when

nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary's name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean where the only communication is in the summer months. Sam, the father of Mary, has been authorized by Mary to sign Mary's name to the § 1.63 declaration and also Sam's name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.
- (B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.
- (E) Sam may sign Mary's name to the declaration since he was authorized by Mary to do so.

The model answer is selection (E).

(E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word "made" implies signing or executing and is derived from § 1.64. See 37 CFR 1.41(c). (A) contains the elements of 37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(I), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorized Sam to inspect the provisional application.

Petitioner argues that answer (B) is a correct answer because while the action taken is correct, the reasoning for the action is incorrect and thus is not in accordance with proper USPTO procedure.

Petitioner's arguments have been considered but are not deemed persuasive. The directions on the front page of the test advised petitioner that **there is only one most correct answer for each question**. The question asks which one of the answer is not in accordance with proper USPTO procedure. Answer (E) is clearly a correct answer. Answer (E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word "made" implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). On the other hand answer (B) is correct in that Sam cannot see the application papers for application B. Accordingly, answer (E) is the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 38 reads as follows:

38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

(A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000.

Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.

(B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.

(C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000. The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.

(D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.

(E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

The model answer is selection (B).

35 U.S.C. § 102(b). The on sale activity by the inventors was not a statutory bar since the one year anniversary ends on Tuesday, June 26, 2001. (A) is not the correct answer. 35 U.S.C. § 102(a). The reference, published before the filing date of the client's application, is prior art under 35 U.S.C. 102(a). The inventive entity is Able and Baker. The authorship is "by others," Able, Baker, and McGeiver. The reference is prior art "by others." See MPEP § 2132 ('Others' Means Any Combination Of Authors Or Inventors Different Than The Inventive Entity), and MPEP § 2132.01. See also *In re Katz*, 215 USPQ 14 (CCPA 1982). (C) is not correct. 35 U.S.C. § 102(b). The invention was placed in public use more than one year before the filing date of the patent application. See MPEP § 2133 (The 1 – Year Time Bar Is Measured From The U.S. Filing Date); MPEP § 2133.03(a); and *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881). (D) is not correct. Although public knowledge may not be a public use or sale bar under 35 U.S.C. 102(b), it can provide grounds for rejection under 35 U.S.C. 102(a). MPEP §§ 2132 and 2133.03(a)(C) (Use by Independent Third Parties). In this instance, the public knowledge is more than one year before the application filing date. (E) is not correct. 35 U.S.C. § 102(b). A "secret" use by another inventor of a machine to make a product is "public" if the details of the machine are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 - 484 (7th Cir. 1975); *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983).

Petitioner argues that (A) is a correct answer because answer (A) is prior art that may not be properly applied to reject claims. Petitioner argues that even if a prima facie case of obviousness exist, the prima face case can be rebutted by filing a disclaiming affidavit.

Petitioner's arguments have been fully considered but are not deemed persuasive. It is clear that the trade article written by a different inventive entity (Able, Baker, and McGeiver) which published prior to the filing of the patent application to Able and Baker is available as prior art under 35 U.S.C. 102(a). By stating that "a prima facie case may exist for using the prior art against Able and Baker", petitioner is actually agreeing that the trade article can be properly applied to reject the claim. Furthermore, an affidavit can be used to overcome the rejection only if there is sufficient evidence to establish the subject matter relied upon in the article was applicant's own invention. Since no additional facts could be assumed, Able and Bake may or may not able to file such affidavit. Accordingly, answer (A) is not correct.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor's patent that Acme fears might cover Acme's key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor's December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent's validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme's costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

The model answer is selection (C).

Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. See, e.g., 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.



Petitioner argues that answer (E) is correct because by placing the information into the owner's possession, patentee may request reexamination. Petitioner further argues that by choosing answer (C), Acme would not participate in all issues of reexamination, such as appealing to the CAFC.

Petitioner's arguments have been fully considered but are not deemed persuasive. The question expressly asks which answer would provide the most reasonable advice to Acme. Answer (E) is less reasonable than answer (C) because contrary to what answer (E) says, informing a competitor of the trade article would not force the competitor to inform the USPTO of the information or force the competitor to initiate a reexamination of its own patent. See 37 CFR 1.56 and 37 CFR 1.97 and 1.98. On the other hand, ACME's *inter partes* reexamination request would force the patentee to address the potential 35 U.S.C. § 102(a) rejection as it relates to the trade magazine publication. Moreover, the *inter partes* reexamination provides active participation by the third-party requester (ACME) throughout the entire reexamination process at the United States Patent and Trademark Office albeit not allowing appeal to the CAFC. Accordingly, answer (C) is the more reasonable answer to the question.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, zero (0) points have been added to petitioner's score on the Examination. Therefore, petitioner's score is sixty-eight (68). This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "R. Spar", is positioned above the printed name and title of the official.

---

Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy